

REMARKS

Reconsideration and allowance of the present application are respectfully requested. Claims 1, 2, 3 and 15 are amended. Claims 1 to 20 are pending.¹

I. Examiner's Arguments

The Office Action states that the arguments presented in the last Amendment filed March 24, 2009, are "moot in view of the new ground(s) of rejection." (Office Action, p. 25, emphasis added). Applicant respectfully disagrees.

In the last Amendment, Applicant argued that Berson failed to teach features of Applicant's claims. For instance, with regard to claim 1, Applicant argued that Berson does not teach "' electronic money data of an electronic money issuer...wherein the **processing data** and the **electronic money data** are **attached** together.'" (See Amendment filed December 1, 2008, p.13).

In the present Office Action, the Examiner still relies on Berson for purportedly teaching the above-noted features argued in the last Amendment. Thus, Applicant's arguments with regard to these features are not moot.

"Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (M.P.E.P. 707.07(f), "Answer All Material Traversed"). Because the Examiner has repeated the rejection based on Berson but has not responded to Applicant's arguments, Applicant is placed at a disadvantage, insofar as its ability to advance the prosecution of the application beyond the response to the prior Office Action. Accordingly, if the current rejection is maintained in the next Office Action,

¹ The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

the next Action cannot be made final so that Applicant is given a full and fair opportunity to respond to any arguments made in reply to this paper and make amendments if necessary. (See M.P.E.P. § 706.07.)

II. Claim Rejections - 35 U.S.C. § 112

Claims 2, 3, 10, 11 and 16 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. The Office Action questions what additional elements are being recited in the step of "relating the received data to be information-processed with the electronic money data " in Applicant's claim 2, in light of the fact that the claim previously recites that "the data to be information-processed and the electronic money data are attached together". Applicant respectfully submits the above mentioned features of claim 2 are definite under 35 U.S.C. § 112, second paragraph, to one having ordinary skill in the art, when Applicant's claims are read in light of the specification. See, for example, page 13, paragraph 0047 of the specification.

As illustrated in Figure 4, the electronic money information and the print data are received together as JOB data. Thereafter, the electronic money information is separated from the print data, so that that electronic money information can be validated. During this time, the print data is temporarily stored. Thus, while the electronic money information and the print data arrive together, they are not kept together during the validation process. By relating the electronic money information and the print data to one another, as recited in the claim, the print data can be properly matched up with the electronic money information after it has been validated.

Claim 3 complies with the requirements for 35 U.S.C. § 112, second paragraph, for reasons similar to those discussed above with regard to claim 2. Claim 16 has been amended to remove the antecedent basis issue raised in the Office Action.

III. Claims Rejections - 35 U.S.C. § 101

Claims 1 to 3, 9 to 11, 15, 16 and 20 are rejected under 35 U.S.C. § 101.

Applicant has amended claims 1, 2, 3 and 15 to identify the machine in which the process is performed, and thereby remove any issues under 35 U.S.C. §101. Accordingly, Applicant requests that the rejection under Section 101 be reconsidered and withdrawn.

IV. Claims Rejections - 35 U.S.C. § 103

Claims 1 to 20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 7,075,666 B1 to Aiyama (referred to herein as "Aiyama") in view of U.S. Patent No. 6,938,154 B1 to Berson et al. (referred to herein as "Berson"), and further in view of U.S. Patent No. 6,338,048 B1 to Mori (referred to herein as "Mori").

Applicant respectfully submits that the purported combination of Aiyama in view of Berson and further in view of Mori cannot support a rejection of claim 1 under 35 U.S.C. § 103(a) because, taken individually or in combination, these references lack disclosing, teaching, or suggesting each claim feature recited in claim 1. (See MPEP § 2143).

The Office Action concedes that both Aiyama and Berson lack disclosing, teaching or suggesting "receiving... information on the electronic money issuer for determining whether the electronic money data is valid", as recited in Applicant's claim 1. The Office Action turns to Mori to allegedly cure this deficiency.

Mori discloses an electronic transaction system for carrying out transaction settlements using electronic money stored on a customer card that is inserted into a card handling unit while using an automatic teller machine. (*Mori*, Abstract, Col. 4, lines 7-27 and FIG. 2). Mori is cited for purportedly teaching the aforementioned claim feature recited in Applicant's claim 1, on the grounds that several digits in a credit card number, obtained from the card, can identify the issuer. (Office Action, p. 7). Applicant respectfully submits that the purported combination of Mori with Aiyama and Berson is improper because Mori's disclosure teaches away from the claimed invention.

"A prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness." (MPEP § 2145 X.D.1). Rebuttal evidence may include evidence presented by Applicant in the specification. Moreover, the Federal Circuit held it is an error not to consider evidence presented in the specification. *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996); *See* MPEP § 2145.

Here, Applicant's specification discloses a payment method using a card apparatus is inferior because a user would have to physically travel to the printer and insert the card into the card apparatus connected to the printer to receive the print processing. (Applicant's specification, p. 2, paragraph 4). Mori, on the other hand, is specifically directed to the use of a physical card as the medium for transferring

electronic money. Note, in particular, that the issues discussed in the Background section of Mori (columns 1 and 2) deal with the mechanisms by which funds are replenished on a card. These issues are not pertinent to transaction systems in which electronic money data is received by a printing system over a network. There is nothing in Mori to suggest that any of its teachings are applicable to network-based payments, as opposed to card-based payments.

Accordingly, Mori's card transaction system cannot be used as a teaching for the above mentioned claim feature in Applicant's claim 1. The purported combination of Aiyama in view of Berson and further in view of Mori, therefore, cannot support a *prima facie* case of obviousness.

Independent claims 2, 3, 4, 5, 8 and 15, although having different scope than claim 1, recite similar distinguishing features to those in claim 1. Accordingly, Applicant respectfully submits claims 2, 3, 4, 5, 8 and 15 are also allowable over Aiyama in view of Berson and Mori for similar reasons set forth above with regard to claim 1.

Additionally, Applicant respectfully submits claims 6, 7, 9-14 and 16-20 are allowable over Aiyama in view of Berson and Mori at least due to their corresponding dependence from one of independent claims 1, 2, 3, 4, 5, 8 and 15.

V. Conclusion

In light of the foregoing, Applicant respectfully requests reconsideration and allowance of the above-captioned application.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 02-4800.

Respectfully submitted,

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